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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,928	03/30/2001	Thomas N. Turba	RA 5390 (33012/320/101)	8178

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EXAMINER

NGUYEN, MERILYN P

ART UNIT

PAPER NUMBER

2171

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DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,928

Applicant(s)

TURBA, THOMAS N.

Examiner

Merilyn P Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Claims 1-20 are pending in this office action.

Specification

2. The disclosure is objected to because of the following informalities: status of copending application must be updated at pages 1-3 of the specification.

At page 4, line 10, there is unknown symbol after "MAPPER".

At page 13, line 15, there is missing word in "Data Wizard a web based interface".

Appropriate correction is required.

Claim Objections

3. Claims 1, 2, 6, 7, 11, 13, 16, and 18 are objected to because of the following informalities:

In claim 1, line 3; in claim 2, line 1; in claim 6, line 4; in claim 7, line 1; in claim 11, line 2; in claim 13, line 1; in claim 16, lines 2 & 4; in claim 18, line 1: "publically" should be -- publicly--.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-10, 15, and 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 6, the term “data wizard” expressed in a lowercase term, which renders the claim indefinite. The term “data wizard” is not defined by the claim, and the specification addresses data wizard as “Cool ICE Data Wizard” in capital, therefore the “data wizard” in the claim is indefinite and does not provide a standard for ascertaining the requisite degree.

Claims 5, 10, 15 and 19 contain the trademark/trade name MAPPER at line 2. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe database management system and, accordingly, the identification/description is indefinite.

Regarding claim 6, at line 10, there is insufficient antecedent basis for “said plurality of steps”. It is unclear whether “said plurality of steps” is the same as “said plurality of ordered steps”.

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Claims 2-5 and 7-10 depend from rejected claims 1 and 6, respectively, and include all the limitations, thereby inheriting its defects.

Claim 20 depends from rejected claim 19 and includes all the limitations, thereby inheriting its defects.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 6, 11, and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 11, and 16 of copending Application No. 09/822686. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations.

Regarding claims 1, 6, and 16 of the instant application, these claims recite all the elements of claims 1, 6, and 16 of the '686 application, except that it further includes the

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limitation of presenting a plurality of valid steps as choices or selections for addition to each of plurality of discreet and independent steps. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the limitation of presenting a plurality of valid steps as choices or selections for addition to each of plurality of discreet and independent steps as claimed in the instant application, since with or without this limitation, the scope of the invention would not being changed. Further more, it's well known in the art that for each step there is always sub steps in order to a complete function. The motivation would have been to expand the overall use of claimed invention at no significant cost.

The subject matter of claims 2, 3, 5, 7-10, and 18-20 of the '686 application are same as claims 2, 3, 5, 7-10, and 18-20 of instant application.

Regarding claim 11 of the instant application, this claim recites all the elements of claim 11 of the '686 application, except that it further includes the iteration/repetition of steps in claim 11 of '686 application. It would have been obvious to one having ordinary skill in the art at the time the invention was made to repeat or iterate the steps of '686 application as claimed in the instant application. The motivation would have been to expand the overall use of claimed invention at no significant cost.

The subject matter of claims 13, 14, and 15 of the '928 application are same as claims 13, 14, and 15 of the instant application.

7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 6-9, 11-14, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Sutter (US 5,924,094).

Regarding claim 1, Sutter discloses in a data processing system (See Fig. 1, Fig. 4) having a user terminal (10 or 14, for example, Fig. 1, and corresponding text) operated by a user which builds a service for accessing a data base management system responsively coupled to said user terminal via a publically accessible digital data communication network (Wan Gateway 12, Fig. 1, and Network 42, Fig. 4, and col. 9, lines 40-47), the improvement comprising:

a data wizard which permits said user to specify said service (See col. 6, lines 28-37, and col. 14, lines 39-45) as an ordered sequence of discreet and independent steps (See Fig. 2c, 2d, where “steps” correspond to activities in “activity group”, and col. 35, lines 4-14) and which presents a plurality of valid steps as choices for addition at each position in said plurality of discreet and independent steps (See col. 37, lines 7-11).

Regarding claim 2, Sutter discloses said publically accessible digital data communication network further comprises the Internet (See col. 9, lines 40-47).

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Regarding claim 3, Sutter discloses said user terminal further comprises an industry compatible personal computer (See Fig. 1, and col. 9, lines 28-32). Since Sutter system runs on the Internet (See col. 9, lines 43-45), having a commercially available browser is inherent because personal computer requires a browser in order to process data through Internet.

Regarding claim 4, Sutter discloses said data wizard inhibits presentation of any step which would not be valid for the corresponding position within said ordered sequence (See col. 37, lines 14-19).

Regarding claim 6, Sutter discloses apparatus comprising:

- a. a user terminal (10 or 14, for example, Fig. 1, and corresponding text);
- b. a data base management system (See col. 6, lines 48-60) responsively coupled to said user terminal via a publically accessible digital data communication network (See col. 9, lines 40-47); and
- c. a data wizard responsively coupled to said user terminal and said data base management system which permits a service to be defined from said user terminal (See col. 6, lines 28-37, and col. 14, lines 39-45) in accordance with an ordered sequence of discreet and independent steps (See Fig. 2c, 2d, where "steps" correspond to activities in "activity group", and col. 35, lines 4-14) and which presents a plurality of valid steps as choices for addition to said plurality of steps for each step of said plurality of ordered steps (See col. 37, lines 7-11).

Regarding claim 7, Sutter discloses said publically accessible digital data communication network further comprises the Internet (See col. 9, lines 40-47).

Regarding claim 8, Sutter discloses said data wizard inhibits presentation of any invalid step for any given one of said ordered sequence (See col. 37, lines 14-19).

Regarding claim 9, Sutter discloses said user terminal further comprises an industry compatible personal computer (See Fig. 1, and col. 9, lines 28-32). Since Sutter system runs on the Internet (See col. 9, lines 43-45), having a commercially available browser is inherent because personal computer requires a browser in order to process data through Internet.

Regarding claim 11, Sutter discloses a method of dynamically building a service from a user terminal coupled via a publically accessible digital data network to a remote data base management system having a component building process (See col. 9, lines 23-39) comprising:

- a. presenting a first plurality of potential steps which are valid for a first position in an ordered sequence of steps which define said service (See col. 37, lines 7-13);
- b. inserting a chosen one of said first plurality of potential steps into said ordered sequence of steps (See col. 37, lines 14-16);
- c. presenting a second plurality of potential steps which are valid for a next position in said ordered sequence of steps (See col. 37, lines 33-36);
- d. inserting a chosen one of said second plurality of potential steps into said ordered sequence of steps (See col. 37, lines 37-60); and

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- e. repeating steps c and d until said service is complete (See col. 37, line 7 to col. 39, line 10).

Regarding claim 12, Sutter further discloses each of said presenting steps inhibits presentation of any potential step which is not valid for said next position within said ordered sequence of steps (See col. 37, lines 14-19).

Regarding claim 13, Sutter discloses publically accessible digital data communication network further comprises the world wide web (See col. 9, lines 40-47, where “the world wide web is read on “the Internet”).

Regarding claim 14, Sutter discloses said user terminal further comprises an industry compatible personal computer (See Fig. 1, and col. 9, lines 28-32).

Regarding claim 16, Sutter discloses an apparatus comprising:

- a. means for permitting a user to access a publically accessible digital data communication network (See Fig. 1 and col. 6, lines 28-37);
- b. means responsively coupled to said permitting means via said publically accessible digital data communication network (See Network 42, Fig. 4) for providing data base management services (See col. 9, lines 40-47); and
- c. means responsively coupled to said permitting means and said responding means for designing a service through specification of an ordered plurality of discreet and

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independent steps (See Fig. 2c, 2d, where “steps” correspond to activities in “activity group”, and col. 35, lines 4-14).

d. means responsively coupled to said designing means for presenting a plurality of valid potential steps for selection of each of said ordered plurality of discreet and independent steps (See col. 37, lines 7-13).

Regarding claim 17, Sutter discloses said presenting means further comprises a means for inhibiting presentation of any step which is invalid for a corresponding position within said ordered plurality of discreet and independent steps (See col. 37, lines 14-19).

Regarding claim 18, Sutter discloses said publically accessible digital data communication network further comprises the Internet (See col. 9, lines 40-47).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5, 10, 15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter (US 5,924,094), in view of Applicant's Admitted Prior Art.

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Regarding claims 5, 10, 15, and 19, Sutter discloses a database management system (See col. 6, lines 20-37) having all of the claimed subject matter except Sutter is silent as to the database management system being a MAPPER data base management system. Applicant admits that the MAPPER database management system was known at the time the invention was made. Since MAPPER DBMS was readily available, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the well known MAPPER data base management as disclosed by Applicant's Admitted Prior Art as the database management system of Sutter. The resultant use of the MAPPER data base management system would have performed the intended (by Sutter) function, without undue experimentation and with expected and obvious result (See applicant's specification, page 4, lines 7-12).

Regarding claim 20, Sutter discloses said permitting means further comprises an industry standard personal computer (See Fig. 1, and col. 9, lines 28-32).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Keeler U.S Patent No. 6,243,696 discloses automated method for building a model.

Regnier U.S Patent No. 6,134,549 discloses client/server computer system having personalizable and securable views of database data.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 703-305-5177.

The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN

MN

April 25, 2003


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